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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1979

NO. 79-1556

CANRON, INC.,

Petitioner,

v.

PLASSER AMERICAN CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1979

NO. _____

CANRON, INC.,

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v.

PLASSER AMERICAN CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Your petitioner, Canron, Inc., respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit entered in this case on September 21, 1979, and the Order of the United States Court of Appeals for the Fourth Circuit denying Petition for rehearing and suggestion for rehearing en banc entered on January 11, 1980.

OPINIONS BELOW

The opinion of the Fourth Circuit Court of Appeals is found at 609 F.2d 1075 and is reprinted herein as Appendix B annexed hereto (infra., p. A-2).

The opinion of the Trial Court, the United States District Court for the Eastern District of Virginia, Norfolk Division, is found at 474 F. Supp. 1010 and is reprinted herein as Appendix C annexed hereto (infra., p. A-4).

JURISDICTION

The judgment of the Fourth Circuit Court of Appeals was entered on September 21, 1979. A petition for rehearing was timely filed and was denied by an Order dated January 11, 1980, which is reprinted herein as Exhibit A annexed hereto (infra., p. A-1). This Petition for a Writ of Certiorari was filed within 90 days thereafter. The jurisdiction of this Court rests on 28 U.S.C. §1254(1).

THE QUESTION PRESENTED

Was the Court of Appeals in error when it held, contrary to other circuits, that anticipation under 35 U.S.C. §102(b) can be based on the combined disclosures of two or more references as compared to a disclosure identical to the claimed subject matter in *a single reference?*

STATUTORY PROVISIONS INVOLVED

The provisions of 35 U.S.C. §102 and 35 U.S.C. §103 are involved in this litigation, and are reprinted herein as Appendix D (infra., p. A-30).

STATEMENT OF THE CASE

Plaintiff below, your petitioner Canron, Inc., brought suit for infringement of U.S. Patent No. Re. 29,437 against Defendant below, Plasser American Corporation, in the District Court for the Eastern District of Virginia, Norfolk Division, Civil Action No. 77-294-N. In its decision dated June 15, 1978 (Appendix C hereto, pages A-4 through A-29 herein), the Trial Court considered the patent claims which define the subject matter to be protected and which are roughly equivalent to the description of the property in a deed, and broke such claims down into their constituent parts or elements for analysis. The Court held Patent Re. 29,437 invalid on the basis of anticipation under 35 U.S.C. §102(b), finding certain claim elements in some prior references and other claim elements in other prior references, but without finding all of the claim elements in a single prior reference. These findings of the Trial Court are summarized in a chart which is found on the following page and which clearly illustrates that all of the elements were *not* found by the Trial Court to be present in any one reference, and that resort to more than one reference is necessary to provide a disclosure of all of the elements of the invalidated claims.

The Trial Court made no findings with respect to obviousness, as support in the testimony was absent, and did not render any decision on the infringement issue.

References Claim 1 Elements	Acknowledged Old In Patent	Plasser British Patent PX86	B-13 Sales Brochure B-20	Drawing Courrier Matisa A-20	Orville Patent PX78	Plasser U.S. Patent PX83	Stewart Patent A-5	Publication "Signal und Schiene" Exhibit U	Mannix Patent PX85	Appendix Page
(a)	X	X	X				X			A-20
(b)	X	X	X							A-20
(c)	X	X	X	X						A-20-21
(d)	X	X	X		X	X	X	X		A-21
(e)	X	X	X		X	X				A-21
(f)		X	X		X		X			A-21-22
(g)		X	X							A-22
(h)		X		X			X			A-22-23
(i)		X	X	X			X			A-23
(j)							X			A-23
Claim 11 Elements										
(a)	X	X	X				X			A-26
(b)	X	X	X							A-26
(c)	X	X	X	X						A-26
(d)	X	X	X		X	X	X	X		A-26
(e)	X	X	X		X	X				A-26
(f)		X	X		X		X			A-26
(g)		X	X							A-26
(h)			X							A-26
(i)		X					X		X	A-26-27
(j)		X					X			A-27
(k)							X			A-27
(l)		X					X			A-27

CHART SUMMARIZING DISTRICT COURT'S ANTICIPATION ANALYSIS
(NOTE: Prior art references are identified by exhibit number)

Plaintiff appealed to the Fourth Circuit Court of Appeals and pointed out that there was no invalidating anticipation because no *one* reference disclosed all of the elements in the same situation and united in the same way to perform a function identical to that of the claimed subject matter, all as previously required by the Fourth Circuit by reason of its decision in *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047 (4th Cir. 1976), cert. denied, 429 U.S. 980 (1976).

At the oral argument on appeal, the Appellate Court brought to the attention of Defendant's counsel the previous requirement, set forth in *Tights*, of disclosure in *a single reference*. In addition, the Court inquired as to whether Defendant had made a defense based on obviousness. Counsel for the Defendant answered in the negative with respect to obviousness, but insisted that anticipation was present, notwithstanding the necessity (apparent from the Trial Court's findings) to resort to more than one reference to find all of the claimed elements.

In its decision dated September 21, 1979, the Fourth Circuit Court of Appeals affirmed per curiam, stating, in part:

> (w)e recognize that there is no anticipation unless all of the same elements are found in the same situation and united in the same way to perform an identical function. 609 F.2d at 1075.

Thus, without explaining its action, the Fourth Circuit, in effect, overruled its previous decision in *Tights* (although paying lip service thereto) by clearly ignoring the previous requirement that all of the same elements must be found in the same situation and united in the same way to perform an identical function *in a single reference*.

Reconsideration and rehearing en banc by the Fourth Circuit was denied on January 11, 1980.

This petition ensued.

REASON FOR GRANTING THE WRIT

I. The decision below of the Fourth Circuit Court of Appeals is in direct conflict on the same matter with decisions of various of the other Courts of Appeals and the Court of Customs and Patent Appeals.

A. The Question Presented

The Trial Court decision, affirmed by the Fourth Circuit Court of Appeals, invalidates the claims of the patent in suit on the basis of anticipation under 35 U.S.C. §102(b) because all of the claim elements were found in various prior printed publications, although no single publication disclosed all of the claim elements. The Trial Court's findings (not disturbed by the Appellate Court) establish conclusively that all of the claim elements were *not* found in *a single publication.* (See the chart on page 4 hereof which illustrates what claim elements were found by the Trial Court in which references.) Simply stated, the question is whether invalidating anticipation is present when resort must be had to more than *one* reference in order to find disclosure of all of the claim elements.

B. The Conflict

Various of the Courts of Appeals have stated on numerous occasions that anticipation requires that all the same elements be found in exactly the same situation and united in the same way to perform the identical function *in a single reference.*

The First Circuit, in *Shanklin Corp. v. Springfield Photo Mount Co.,* 521 F.2d 609, 616 (1st Cir. 1975), cert. denied, 424 U.S. 914 (1975) stated:

> (t)o anticipate under Section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way.

The Second Circuit in *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.,* 372 F.2d 263, 267 (2d Cir. 1967) stated:

> (u)nder Sections 101 and 102 of the patent laws, an inventor is entitled to a patent if he discovers a "new and useful improvement" on a machine that was not "known or used by others." There can be little doubt that the . . . patent satisfies the relatively liberal tests of these Sections. Section 103 indicates that Sections 101 and 102 prevent patentability only where the invention was "identically disclosed" by the prior art.

The Third Circuit, in *Paeco, Inc. v. Applied Moldings, Inc.,* 562 F.2d 870, 875 (3rd Cir. 1977) stated:

> (a)nticipation occurs only when some *single* prior article, patent, or publication contained within its four corners every element of the claim in question; a patent is not anticipated when its elements are distributed among several prior publications or devices. (Emphasis added.)

The Fifth Circuit, in *Van Gorp Mfg., Inc. v. Townley Industrial Plastics, Inc.,* 464 F.2d 16, 18 (5th Cir. 1972) stated:

> (t)his Court has held that novelty is lacking if *all* of the elements of the patent, or their equivalents are found *in a single prior art structure.* . . . (Emphasis by the court.)

The Sixth Circuit, in *American Seating Co. v. National Seating Co.,* 586 F.2d 611, 618 (6th Cir. 1978), cert. denied, 441 U.S. 907 (1979) stated:

> (t)his Court has repeatedly defined the proper standard with respect to anticipation as requiring that all the elements of a patented device *or their equivalents* be found in a single pre-existing structure or description. (Emphasis by the court.)

In *Tee-Pak, Inc. v. St. Regis Paper Co.,* 491 F.2d 1193, 1198 (6th Cir. 1974) the Sixth Circuit Court of Appeals found that the District Court committed reversible error by relying on a combination of references to anticipate a claim. Quoting from an earlier decision, *Allied Wheel Products, Inc. v. Rude,* 206 F.2d 752, 760 (6th Cir. 1953), the court stated:

> "(i)n order to anticipate an invention it is necessary that all of the elements of the invention or their equivalents be found in one *single* description or structure, where they do substantially the same work in substantially the same way." (Emphasis added.)

The Seventh Circuit, in *Popeil Bros., Inc. v. Schick Elec., Inc.,* 494 F.2d 162, 164 (7th Cir. 1974) stated:

> (a) previous patent, printed publication or domestic product anticipates a purported invention only where, except for insubstantial differences, it contains all of the same elements operating in the same fashion to perform an identical function.

In *Amphenol Corp. v. General Time Corporation,* 397 F.2d 431, 438 (7th Cir. 1968), the Seventh Circuit stated:

> (a)s a rule, in order to have anticipation, all of the elements of the patented device or their equivalents must be found in a *single* prior device. (Emphasis added.)

The Eighth Circuit, in *Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co.,* 215 F. 362, 369 (8th Cir. 1914) stated:

> (i)t constitutes no anticipation and no defense to a claim of infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that all of them, or their mechanical equivalents, be found in the same description or machine, where they do substantially the same work by the same means. Imheuser v. Buerk, 101 U.S. 647, 660, . . . ; Bates v. Coe, 98 U.S. 31, 48. . . .

The Ninth Circuit, in *Stauffer v. Slenderella Systems of California, Inc.,* 254 F.2d 127, 128 (9th Cir. 1957) stated:

> (a)nticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a prior pleaded patent, there is no anticipation.

The Court of Customs and Patent Appeals, in *Application of Marshall,* 578 F.2d 301, 304 (C.C.P.A. 1978) stated:

> (t)o constitute an anticipation, all material elements recited in a claim must be found in *one* unit of prior art. (Emphasis added.)

In *Application of Royka,* 490 F.2d 981, 984 (C.C.P.A. 1974) the Court of Customs and Patent Appeals stated:

> (i)t is elementary that to support an anticipation rejection, all elements of the claim must be found in the reference.

To the contrary, the decision below of the Fourth Circuit clearly ignores the requirement of full disclosure in *a single reference.*[1] It is especially noteworthy that, prior to the decision below, the Fourth Circuit, in *Tights,* adopted the standards set forth by the Ninth Circuit requiring full disclosure in *a single reference.* Thus, prior to the Fourth Circuit's decision below wherein anticipation is erroneously based on the finding of some claim elements in one reference and of other claim elements in other references, the Fourth Circuit was in harmony with the general rule. Specifically, in *Tights,* the Fourth Circuit adopted the rule set forth in *Ceramic Tilers Supply, Inc. v. Tile Council of America, Inc.,* 378 F.2d 283, 284-285 (9th Cir. 1967). Quoting from an earlier decision, *Walker v. General Motors Corp.,* 362 F.2d 56, 58 (9th Cir. 1966), the Ninth Circuit stated:

> (a)nticipation is a technical defense which must meet strict standards: " 'Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function' in a *single* prior art reference 'there is no anticipation.' " (Emphasis added.)

Furthermore, the Fourth Circuit decision below, contrary to the doctrine of stare decisis, cites *Tights* as precedent, while silently overruling the *single reference* requirement

[1] The Tenth Circuit, in addition to the Fourth Circuit, has also deviated from the time honored standard of anticipation requiring identical disclosure in a single reference. Thus, the Tenth Circuit in *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F.2d 381, 398 (10th Cir. 1965), cert. denied, 383 U.S. 933, rehearing denied, 384 U.S. 947, cert. denied, 385 U.S. 990, rehearing denied, 385 U.S. 995 (1966) stated:

> (o)f course, to establish anticipation in such a situation, it is not necessary that all of the elements be found in a single patent or publication. It is enough if the whole of the prior art considered together discloses all of the claimed elements and that no new functional relationship arises from their combination.

without acknowledging this critical difference or giving any explanation.

It is significant to note that this Court made only fleeting reference to anticipation and 35 U.S.C. §102 in *Graham v. John Deere Co.,* 383 U.S. 1, 12 (1965), and that this Court has not spoken authoritatively with respect to anticipation since before 1900, long prior to enactment of the present statute in 1952.[2]

Thus, this petition is responsive to a recent departure from a substantially harmonious previous expression of the law of anticipation which required that all of the

[2] The law of anticipation stems from early United States Supreme Court decisions, being expressed by the Supreme Court as early as 1878 in the landmark decision of *Bates v. Coe,* 98 U.S. 31 (1878). In this case, the patent in suit related to a hand drill and screw cutter consisting of a combination of five elementary parts. The defense pleaded that the invention was old and cited several prior patents, each of which disclosed certain of the elementary parts of the patented combination, but none of which disclosed the complete invention. Mr. Justice Clifford, writing for the Court, rejected this piecemeal approach, stating:

> (w)here the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement. 98 U.S. at 48.

Citing *Bates v. Coe,* the Supreme Court again rejected the "pick-and-choose" approach to anticipation in *Imhaeuser v. Buerk,* 101 U.S. 647 (1879), and again in *Parks v. Booth,* 102 U.S. 96 (1880).

(Alternatively, this petition may be considered as being based on a conflict between the Fourth Circuit Court of Appeals and the early decisions of this Court in connection with interpretation of the statutory predecessors to 35 U.S.C. §102(b). Either way, the result is that the decision below is in conflict with the decisions of the other Courts of Appeals, or in conflict with precedent enunciated by this Court.)

same elements be found in exactly the same situation and united in the same way to perform the identical function in *a single prior art reference.*

Furthermore, not only is the Fourth Circuit decision below in conflict with decisions of other Courts of Appeals, it is also in conflict with the statutory design of Congress enacted in 1952. More specifically, 35 U.S.C. §103 states that a claim may be unpatentable due to obviousness when "the invention is not identically described or disclosed" as set forth in 35 U.S.C. §102. Thus, the interaction of 35 U.S.C. §102 and 35 U.S.C. §103 provides either: (1) for invalidating anticipation under 35 U.S.C. §102, when there is an identical disclosure in a single reference, as for instance, as required in 35 U.S.C. §102 (b) in "a printed publication"; or (2) for invalidating obviousness under 35 U.S.C. §103, when "the differences between the subject matter sought to be patented and the prior art . . . would have been obvious at the time the invention was made to a person having ordinary skill in the art."

It is apparent from the foregoing that the abandonment by the Fourth Circuit of the rule requiring full or complete disclosure in a single reference, i.e., "the identically described" requirement set forth in 35 U.S.C. §103, presents a significant departure from the statutory design of 35 U.S.C. §102 and §103.

The essence of the conflict is: Does invalidating anticipation under 35 U.S.C. §102(b) require identical disclosure in a single reference as required by numerous of the Circuit Courts of Appeals, and by the Court of Customs and Patent Appeals, and by the interaction of 35 U.S.C. §102 and 35 U.S.C. §103; or can invalidating anticipation be present when resort must be had to *more*

than a single reference in order to find disclosure of all of the elements of the claimed subject matter, as in the decision below for which review is sought.

C. The Importance Of Reviewing The Conflict

It is essential to the future well-being of the patent system and to the urgent need in this country for innovative advancement that disharmony or uncertainty with respect to the meaning of anticipation be eliminated and that the appropriate standard for anticipation be authoritatively delineated, so that both patentees and the public will be better able to ascertain their positions with respect to existing patents.

More specifically, conflicts between circuits, particularly with respect to such a basic concept as anticipation, are especially undesirable in view of the nationwide scope of the patent grant and the consequence that the same patent is often evaluated for validity, infringement, and/or licensing by numerous individuals in different circuits. Thus, if the various circuits have differing rules of law, legal conclusions as to validity, infringement, and/or licensing will vary from one part of the country to another. Obviously, this situation is highly undesirable and therefore it is clearly in the national interest that the development of patent law be supervised by this Court so as to eliminate conflicts between the various circuits with respect to patent law and, as noted, particularly with respect to such a basic concept as anticipation. Certainty and uniformity of the law are essential to a hospitable environment for productive, innovative activity which is particularly urgently needed in these times.

SPECIAL AND IMPORTANT ADDITIONAL REASONS BEYOND THE MERE EXISTENCE OF CONFLICT WARRANTING THE GRANTING OF CERTIORARI

It is essential to the future well-being of the patent system that further variations of the standards for anticipation be precluded by reason of a definitive and authoritative ruling by this Court on anticipation, setting forth guidelines to be followed in order to uphold the statutory requirement of identical disclosure in a single reference under 35 U.S.C. §102. As pointed out earlier, this Court has not recently spoken in the area of anticipation and its direction is urgently needed to prevent further loss of legal comprehension and orderliness by reason of judicial changes which blur the clarity of linguistic expression needed for understanding of legal words of art, such as anticipation.

In the event this Court does not grant certiorari, anticipation as a defense under 35 U.S.C. §102(b) will no longer have a uniform meaning as provided for in the statute. If the patent statute is to be given effect as enunciated by Congress, i.e., if both 35 U.S.C. §102 and 35 U.S.C. §103 are to be given effect, acceptance of this petition by this Court is highly desirable to prevent unwarranted deviation from the statutory design of anticipation as a distinct concept in patent law.

It is also believed that it is highly undesirable, particularly in patent law, for previous case law to be silently overruled as has occurred in this case. Specifically, the decision of the Fourth Circuit appears to rely on *Tights* when, in effect, the decision below silently overturns *Tights* by eliminating the requirement of disclosure *in a single reference*. Such silent changes in the law, without

explanation or justification, are clearly to be avoided if the common law principle of stare decisis is to be preserved. Acceptance of this petition is thus especially significant and important to the preservation of the concept of stare decisis.

CONCLUSION

For all of the above reasons, it is respectfully submitted that this petition for a Writ of Certiorari should be granted.

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APPENDIX A

United States Court of Appeals

For the Fourth Circuit

No. 78-1655

Canron, Inc.,

Appellant,

versus

Plasser American Corporation,

Appellee.

ORDER

Upon consideration of the appellant's petition for rehearing and suggestion for rehearing en banc, and no judge having requested a poll on the suggestion for rehearing en banc,

It is ADJUDGED AND ORDERED that the petition for rehearing is denied.

Entered at the direction of Judge Breitenstein for a panel consisting of Judge Breitenstein, Judge Widener and Judge Phillips.

For the Court,

William K. Slate, II
CLERK

FILED
JAN 11 1980
U.S. Court of Appeals
Fourth Circuit

APPENDIX B

UNITED STATES COURT OF APPEALS

For The Fourth Circuit

No. 78-1655

CANRON, INC.,

Plaintiff-Appellant,

- v -

PLASSER AMERICAN CORPORATION,

Defendant-Appellee.

Appeal from the United States District Court for the Eastern District of Virginia, Norfolk Division. J. Calvitt Clarke, Jr., District Judge.

Argued April 4, 1979 Decided September 21, 1979

Before Breitenstein*, Widener and Phillips, Circuit Judges.

Robert E. Clemency (Paul R. Puerner, Michael, Best & Friedrich; Joel A. Kolodny, Seawell, McCoy, Dalton, Hughes, Gore & Timms, on briefs) for Plaintiff-Appellant.

Alfred H. Plyer, Jr. (Daniel C. McEachran, on brief) for Defendant-Appellee.

PER CURIAM:

Plaintiff-appellant Canron, Inc., sued Plasser American Corporation, defendant-appellee, for infringement of a patent on a lifting and lining device used on tamping machines in the maintenance of railway tracks. The district court held that Patent Re 29,437 was invalid because anticipatory disclosures of all elements appeared in printed publications available to the public more than one year before the patent application. Hence 35 U.S.C. § 102(b) precluded entitlement to the patent. The plaintiff appeals and we affirm.

* Of the Tenth Circuit, sitting by designation.

The district court described the machine, detailed the anticipatory disclosures, analyzed the individual claims on which the plaintiff relies, and held that each was disclosed in the publications. No good purpose would be served by a restatement of the facts and issues.

The plaintiff argues that the findings of the court on certain facts are clearly erroneous. We may not weigh the evidence, pass on the credibility of witnesses, or substitute our judgment for that of the finder of the facts. Tights, Inc. v. Acme-McCrary Corp., 4 Cir., 541 F.2d 1047, 1055-1056. We recognize that there is no anticipation unless all of the same elements are found in the same situation and united in the same way to perform an identical function. Id. at 1056. The findings of the trial court that the publications satisfied this principle are based on just and reasonable inferences which we may not disturb. See Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U.S. 100, 123.

We affirm on the trial court's comprehensive findings of fact and conclusions of law and order that the trial court's opinion be published. See Canron, Inc. v. Plasser American Corporation, E.D.Va., — F. Supp. —.

AFFIRMED

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Norfolk Division

CANRON, INC., Plaintiff,	)	
v.	)	CIVIL ACTION
PLASSER AMERICAN CORPORATION,	)	NO. 77-294-N
Defendant.	)	

OPINION AND ORDER

This is a patent infringement action. The plaintiff, Canron, Inc., a New York corporation with its principal office and place of business at West Columbia, South Carolina, has asserted that the defendant, Plasser American Corporation (Plasser), a Delaware corporation with its principal office and place of business at Chesapeake, Virginia, is infringing U. S. Patent Re. No. 29,437, which is a reissue of U. S. Patent No. 3,832,952, by manufacturing and selling machines embodying the claimed subject matter of the reissue patent.

Plasser has denied that it infringes the patent in suit and takes the position that the patent is invalid, not infringed and unenforceable, on the bases that there has been public disclosure prior to the critical date of all novel elements of the subject matter of the patent, that Plasser's machines are materially different than the subject matter of the patent, that file wrapper estoppel applies and that Plasser has intervening rights.

Jurisdiction of this Court is based on 28 U.S.C. § 1338. The trial of the matter began on April 10, 1978. Following trial, each party submitted post-trial memorandum of law and proposed findings of fact. On May 8, 1978, the parties submitted reply memoranda.

Canron and Plasser have for some years been competitors in the design, manufacture and sale of railroad track maintenance equipment. Each party is associated with a European organization: Canron is related by ownership to a Swiss company, Matisa Materiel Industries S.A. (Matisa), and Plasser is related by ownership to one or more Austrian companies (Plasser Austria).

The subject matter of the patent in suit is the lifting and lining device used on a tamping machine. Although the mechanism is apparently compatible with other railway maintenance equipment, chief reference during trial was made to its use on tamping machines. Tamping machines with lifting and lining capacity have been in use since the early 1960's. A tamping machine operates by engaging the track, either by the rail head or the rail base, lifting the rail vertically and compacting or tamping the ballast under the railroad ties, and lining the track horizontally. The use of tamping machines is made necessary by the constant settling of ballast, and therefore the track atop the ballast, under the loads of railway vehicles traveling over the track.

The lifting and lining mechanisms that preceded the device in the patent in suit operated largely by the use of roller clamps, mounted on a common support frame, that engaged the rail head by pivoting on an axis longitudinal with the track in an arched motion. The arched motion made it difficult to work in the area of a frog, the cross-over point or switch area where two sets of tracks con-

verge, because the arched motion required more clearance between rails than was afforded in a frog area and because the clamps could not engage the extra width and weight of a frog in a sufficiently secure manner. The area of a frog is in special need of tamping because the normal weight of traffic moving over the track is compounded in frog areas since the frog, in order to allow passage of the flanged wheels of a railway vehicle to a different track, must include gaps at points in the track where the vehicle traveling through the frog must dismount one track and remount another, resulting in greater impact at these points.

Matisa built a prototype of the patent lifting and lining device on its tamping machine, the Matisa B-13, which efficiently operated to lift and line tracks in a frog area. The mechanism operates by the use of gripping members mounted on an articulated support frame displaceable vertically and horizontally by means of hydraulic jacks. The gripping members cooperate to engage the rail head or rail base with flanged wheels, the "rail engaging means." The flanged wheels are mounted on a carrier frame that is displaceable in the horizontal plane transversely to the track. Because the distance between the flanged wheels is less than the usual distance between the interior edges of railway tracks, the carrier frame for the flanged wheels must be moved into engagement with one rail at a time. The rail is engaged on each side by the opposing pressure from the flanged wheel on the interior of the rail head or rail base and from the gripping members on the exterior edge. The ability of the mechanism to move into an engaging position with a single rail by the use of vertical and horizontal motions, or double straight line motion, rather than arched motions, permits the use of the patented mechanism in the close confines of a frog area.

The mechanism was patented by Matisa in Europe, and sales promotion work was begun in the late part of 1971. On November 24, 1972, using the same design as used in the Matisa B-13, Canron applied for a patent in the United States. The patent, U. S. Patent No. 3,832,952, was issued September 3, 1974. A reissue patent was applied for and the reissue patent, U. S. Patent Re. No. 29,437, the patent in suit, was issued October 11, 1977.

On the basis of all the evidence, this Court finds and concludes that plaintiff's U. S. Patent Re. No. 29,437, which is a reissue of U.S. Patent No. 3,832,952, is invalid by virtue of having been described sufficiently in printed publications disseminated more than one year prior to the original patent application in the United States. The prior publication invalidates the contested claims of the patent in suit. Because of this finding, the Court determines that it is unnecessary to reach the issues of whether the pertinent claims of the original patent and the reissue patent are substantially dissimilar, of whether file wrapper estoppel applies, and if the patent had been found to be valid, of whether Plasser machines infringed the patent.

The statutory section governing prior publication is 35 U.S.C. § 102(b), which reads, in pertinent part:

> A person shall be entitled to a patent unless —
> . . .
>
> (b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for the patent in the United States. . . .

The parties agree that the application for a patent was first filed in the United States on November 24, 1972. Therefore, the "critical date" with respect to publication is November 24, 1971.

The burden of proof to defeat patentability by establishment of prior publication rests with Plasser, who must prove disclosure by clear and convincing evidence, *The Soundscriber Corp. v. United States,* 360 F.2d 954 (Ct. Cl. 1966). There are three elements of publication: (1) the date of the publication; (2) the sufficiency of the description; and (3) the extent of the distribution.

The publication must be in the hands of the "public" prior to the critical date, November 24, 1971. The date of a mailed document for this purpose is the date it reaches the addressee. *Protein Foundation, Inc. v. Brenner,* 151 U.S.P.Q. 561 (D. D.C. 1966). The dates of some documents are conceded by the plaintiff.

The plaintiff does not concede the element of sufficiency of the description as to any document or as to all the documents taken together. A sufficient description is one that, in clear and exact terms, describes the invention with enough specificity to enable a person skilled in that field, at that time, prior to the critical date, "to practice the invention." *Ballantyne Instruments & Electronics, Inc. v. Wagner,* 145 U.S.P.Q. 408 (6th Cir. 1965).

For a document to be "published" under 35 U.S.C. § 102(b), it must be accessible to the public, defined as the members of the public who are likely to be concerned with and interested in the field of art to which the document relates, *The Garrett Corp. v. United States,* 422 F.2d 874 (Ct. Cl. 1970). It is not a defense to an allegation of prior publication that the document was published in a foreign publication unknown in the United States, *Bone v. Commissioners of Marion County,* 251 U.S. 134 (1919). Elements to be considered in determining whether the extent of distribution is sufficient to constitute publication are the number of copies made and their

availability to the public, the dissemination of the document and the intent of the distribution. Distribution to commercial organizations without restriction on their use of the document or injunction of secrecy constitutes publication, *The Garrett Corp. v. United States,* 422 F.2d 874 (Ct. Cl. 1970). Detailed data sheets accompanying offers for sale of the invention that are privately distributed, *Griswold v. Oil Capital Valve Co.,* 152 U.S.P.Q. 95 (10th Cir. 1966), and catalogues distributed generally to the relevant trade, *Jockmus v. Leviton,* 28 F.2d 812 (2d Cir. 1928), are sufficient to constitute publication. The plaintiff concedes sufficiency of dissemination as to some documents.

The plaintiff has raised the issue of infringement as to claims 1, 2, 3, 5, 6 and 11 of the patent in suit. Claims 1 and 11 are independent claims, and claims 2, 3, 5 and 6 are claims dependent on claim 1. The language of the claims in question is set out below.

> 1. Appartus for the vertical and lateral movement of a section of railway track wherein gripping members operated so as to be able to grip the two lines of rails are mounted on at least one support frame connected by articulated connecting members to a chassis movable on the track, which support frame is movable both vertically and laterally relative to said chassis under the action of lifting members or lining members, in order to move said track section and to bring it into a predetermined reference position, characterized in that said gripping members are provided for each side of the track and are transversely displaceable, substantially in a straight line along said support frame; and in that rail engaging means, for each side of the track, are mounted on the support frame and are operable to engage the track so as to face the gripping members for the same side of the track.

2. Apparatus as claimed in claim 1 in which said gripping members are also vertically displaceable in a straight line relative to said support frame.

3. Apparatus according to claim 1, characterized in that each gripping member of a line of rails is height-adjustably mounted on an intermediate chassis which is itself displaceably mounted on said support frame in a plane parallel to the plane of the track and transversely thereto.

5. Apparatus according to claim 1, characterized in that the support frame extends at least over the entire width of the railway track and supports the gripping members and the rail engaging means of two lines of rails of said track.

6. Apparatus according to claim 5, characterized in that the articulated connecting members connecting the support frame to the chassis of the vehicle comprise control members for moving said support frame longitudinally to the track or rotating the same in a plane substantially parallel to the plane of said track.

11. Apparatus for the vertical and lateral movement of a section of railway track wherein gripping members operated so as to be able to grip the two lines of rails are mounted on at least one support frame connected by articulated connecting members to a chassis movable on the track, which support frame is movable both vertically and laterally relative to said chassis under the action of lifting members or lining members, in order to move said track section and to bring it into a predetermined reference position, characterized in that said gripping members are provided for each side of the track and are transversely displaceable, in a straight line, along the support frame and vertically displaceable in relation to the support frame; and rail engaging means comprising single flange wheels, for each side of the

track, are mounted on the support frame and rest, in operative position, vertically and horizontally on the rails, the single flanges of the said flanged wheels being located so as to face the gripping members for the same side of the track.

U.S. Patent Re. No. 29,437; Plaintiff's Exhibit 73 (parantheticals [sic] and emphasis relating to reissuance deleted).

Essentially, the claims taken together represent an apparatus in which gripping members (hooks) for each side of the track are displaceable horizontally and vertically in relation to a support frame, extending over the entire width of track, which itself may be rotated in a plane parallel to the track, and is displaceable in a plane parallel to the track and transversely of the track by the use of articulated connecting members (hydraulic jacks). A support frame (sub-chassis) supports rail engaging means (flanged wheels) which are operable to engage the track by facing the gripping members.

Each document raised by the defendant as anticipatory of the patent will be considered, first to determine whether it was disseminated prior to the critical date and, if so, second, to determine whether the extent of its dissemination constitutes publication. The documents, individually and in their totality, *see In re Palmquist,* 319 F.2d 547 (C.C.P.A. 1963), *overruled on other grounds, In re Foster,* 343 F. 2d 980 (C.C.P.A. 1965), which are determined to be printed publications under 35 U.S.C. § 102(b) will be used by the Court to determine with regard to each claim whether the disclosures therein are sufficiently specific to allow a person knowledgeable in the field of railway maintenance vehicles in November 1971, to "practice the invention." The state of the art is provided by the information in the file wrapper of the patent application of the patent in suit and its predecessor patent, by

patents in the field that preceded the critical date and by the testimony of those witnesses knowledgeable in the field in November 1971.

The documents raised by the defendant as anticipatory are:

(1) Identical advertisements by Matisa in three publications, defendant's Exhibits T, A-14 and A-15. Exhibit T is a German language advertisement in the journal "Eisenbahntechnische Rundschau," the German language version of the "Railway Technical Review," bearing the date July and August 1971. Exhibit A-14 is an English language advertisement in the journal "Railway Gazette International" bearing the date October 1971. Exhibit A-15 is a German language advertisement in the journal "Der Eisenbahn Ingenieur" bearing the date August and September 1971.

(2) A document apparently printed by or at the direction of Matisa celebrating its twenty-fifth anniversary in 1970, found in French in defendant's Exhibit A-20 and in German in defendant's Exhibit Q under the name "Courrier Matisa." There is no translation provided, and therefore the Court cannot determine the extent of textual disclosures therein. However, the schematic representations in the documents are considered.

(3) A note in the German language journal, "Signal und Schiene," which bears the date December 1970 and is defendant's Exhibit U, summarizes the article from "Courrier Matisa" describing the Matisa B-13. Exhibit U is translated in defendant's Exhibit Z.

(4) An article about railway maintenance machines, defendant's Exhibit A-18, in the journal "Eisenbahntechnische Rundshau," the German language version of

the "Railway Technical Review," bearing the date July and August 1971. A translation of the portion of the article dealing with the Matisa B-13, the prototype of the patented lifting and lining tamping machine, is found in defendant's Exhibit Y.

(5) A letter and a descriptive enclosure from Matisa to a Spanish company, defendant's Exhibit B-21, translated in defendant's Exhibit B-22, relating to the advantage of and a technical description of the Matisa B-13.

(6) A sales brochure printed by or at the direction of Matisa, including photographs of and technical specifications for the Matisa B-13, in French, defendant's Exhibit B-20; in German, defendant's Exhibits O and B-34; and in English, defendant's Exhibit P.

(7) A typewritten description on Matisa letterhead, defendant's Exhibit R, translated in defendant's Exhibit A-1, representing to be a description and technical data of the tamping machine, the Matisa B-13, and bearing the date October 1, 1971.

(8) A letter and accompanying enclosures, some of which are not before the Court, from Matisa to Professor Gerhard Schramm, author of several editions of the book, "Oberbautechnik and Oberbauwirtschaft," which means "Railway Maintenance Machinery Technique and Economy." The letter is dated November 8, 1971, and is defendant's Exhibit A-47 and B-26, with a translation in defendant's Exhibit A-48.

(9) An article, defendant's Exhibit A-19, entitled "Tamping Switches and Plain Track in Confined Areas," in "Railway Engineering International," bearing the date November 1971.

(10) Brief description in defendant's Exhibit A-17, from the journal "Eisenbahntechnische Rundschau" bearing the date November 1971, and translated in defendant's Exhibit X.

(11) Brief description in defendant's Exhibit A-16, from the journal "Railway Gazette International" bearing the date November 1971.

The Court presumes the date a document bears to be the date of its publication, unless proof by extrinsic evidence is offered that the date of publication is other than the date the document bears. For example, the Matisa advertisements in the first group of allegedly anticipatory documents are found in periodicals bearing the dates July and August 1971 (Exhibit T); October 1971 (Exhibit A-14); and September 1971 (Exhibit A-15). The Court presumes the date of publication of each advertisement to have been prior to the critical date. Since no contrary evidence has been offered, and in this instance, in fact, because the plaintiff agrees, the Court so finds.

The "Courrier Matisa" brochure (Exhibits A-20 and Q) indicates only that it celebrates an anniversary of the Matisa organization that occurred in 1970. The plaintiff, however, agrees that the brochure was published before the critical date. The Court so finds.

The journal "Signal und Schiene," (Exhibit U) bears the date December 1970. The plaintiff agrees that the date of publication of "Signal und Schiene" was prior to the critical date, and the Court so finds.

The journal "Eisenbahntechnische Rundshau" (Exhibit A-18) bears the date July and August 1971. The plaintiff agree that the date of publication was prior to the critical date, and the Court so finds.

The letter and descriptive enclosure from Matisa to a Spanish company (Exhibit B-21) bears the date December 2, 197-. The final digit in the date is obscured in the copy made available to the Court. In the translation, the date is represented as 1970; this date comports with the language of the letter promising production of the Matisa B-13 in early 1971 and delivery by late 1971. The Court presumes the date of publication to have been prior to the critical date. Since no contrary evidence has been offered, the Court so finds.

The sales brochure for the Matisa B-13 (Exhibits B-20, B-34, O and P) does not bear a date. However, the plaintiff has admitted that the sales brochure was disseminated with a letter, the German language version of which is defendant's Exhibit A-31, translated in defendant's Exhibit A-32, which bears the date November 3, 1971. Willibald Kurzweil, employed by Oberau Riebel in Kaufbeuren, West Germany, a potential customer of Matisa, testified that the letter and brochure sent to his firm was received on November 8, 1971. His statement was based on the date stamp of his firm on the letter sent to Oberau Riebel, defendant's Exhibit B-33, and on Kurzweil's independent recollection of receipt of the letter and brochure. There being no evidence to the contrary, the Court finds that the letter and sales brochure were disseminated prior to the critical date.

The typewritten description on Matisa letterhead of the Matisa B-13, Exhibit R, bears the date October 1, 1971. The Court presumes the document to have been published prior to the critical date. Since there is no evidence to the contrary, the Court so finds.

The letter and enclosures in the eighth group of allegedly anticipatory documents, Exhibits A-47 and B-26,

sent to Professor Schramm bear the date November 8, 1971. Furthermore, Professor Schramm testified that his notations on the letter indicate that he received the letter and enclosures on November 11, 1971. The Court finds that the letter and enclosures were disseminated prior to the critical date.

The article, "Tamping Switches and Plain Track in Confined Areas," Exhibit A-19, appeared in the journal "Railway Engineering International," bearing the date November 1971. Plaintiff's Exhibits 90 and 91 indicate clearly that the periodical for November 1971 was not published or received by subscribers until after the critical date. Disclosures in defendant's Exhibit A-19 are not pertinent to the issue in this case.

The brief descriptions of the Matisa B-13 that appeared in "Eisenbahntechnische Rundschau" and "Railway Gazette International" bear only the dates of those journals: November 1971. Without evidence as to the specific dates in November 1971 that these periodicals were published, the Court is unable to find that the descriptions were prior to the critical date. Disclosures in defendant's Exhibits A-16 and A-17 are not pertinent to the issue in this case.

Material published in periodicals before the critical date have clearly been disseminated to a wide enough segment of the public to constitute sufficient publication. Hence the Matisa B-13 advertisements (Exhibits T, A-14 and A-15), which appeared in three trade periodicals, have been sufficiently disseminated. The note on the Matisa B-13 in "Signal und Schiene" (Exhibit U) and the article in "Eisenbahntechnische Rundshau" (Exhibit A-18) have also been sufficiently disseminated.

The Court finds that the brochure "Courrier Matisa" (Exhibits A-20 and Q) was disseminated to a sufficient number of persons to constitute publication. The fact that the brochure was available to the editors of the journal "Signal und Schiene" and that a synopsis of the text of the brochure was permitted in "Signal und Schiene" indicates a condition and position consistent with unrestrained dissemination.

The Court determines that there is no evidence before it regarding the letter and enclosed technical description sent by Matisa to the Spanish company. There is no information before the Court as to the nature of the company to whom the letter is addressed. Though the addressee is invited by Matisa to forward ths enclosed technical description to the Spanish railway system, Caffari Renfe, there is no evidence of actual dissemination to other than the addressee. The Court will consider the language in the letter as indicative of Matisa's attitude toward dissemination, but will not consider the documents in Exhibit B-21 as printed publications disseminated to a sufficient portion of the public under 35 U.S.C. § 102(b).

The Court determines that the sales brochure (Exhibits O, P, B-20 and B-34) was disseminated to a sufficient portion of the public to constitute publication. The plaintiff has admitted that the sales brochure accompanied letters sent in a mass mailing to potential customers of Matisa and the Matisa B-13. The element of sufficiency of dissemination has been admitted as to this sales brochure.

The defendant has not established that the typewritten specifications for the Matisa B-13, found in Exhibit R were disseminated to the public. The patent advisor for

the defendant's Austrian relation, Plasser Austria, admitted that Exhibit R was almost certainly sent to the German national railroad by Matisa in confidence, a position bolstered by the fact that the Matisa B-13 was tested by the German national railroad in Mannheim. Further distribution of Exhibit R was admitted by the plaintiff was to an agent of Matisa in Norway and to Professor Schramm, for use in an updated edition of his book on railway maintenance machinery. The brochure was received by Professor Schramm less than two weeks before the critical date, and (1) no further dissemination of that brochure occurred and (2) publication of the updated edition of the book could not possibly have occurred before the critical date. The Court finds that Exhibit R, the typewritten specifications for the Matisa B-13, was not sufficiently disseminated to constitute publication.

The finding regarding the typewritten specification also applies to the letters and photographic enclosures sent by Matisa to Professor Schramm. Though the letter was sent and received before the critical date, no public dissemination of the specifications was anticipated or occurred before the critical date or at any later time. The Court finds that Exhibits A-47 and B-26 were not sufficiently disseminated to constitute a publication.

The Court finds, after considering the date and extent of dissemination that the following documents were "printed publications" under 35 U.S.C. § 102(b):

(a) Advertisements by Matisa for the Matisa B-13 (Exhibits T, A-14 and A-15);

(b) The drawing, but not the text, in "Courrier Matisa" (Exhibits A-20 and Q);

(c) The note describing the Matisa B-13 in "Signal und Schiene" (Exhibit U);

(d) The article of the Matisa B-13 in "Eisenbahntechnische Rundshau" (Exhibit A-18); and

(e) The Matisa B-13 sales brochure printed in German, French and English (Exhibits B-20, B-34, O and P).

With regard to the category (e) printed publications, the defendant has made as an exhibit in this case enlargements of photographs in the sales brochure. The enlargements were obtained by rephotographing the photographs printed in the brochure and printing enlarged photographs from the negatives so procured. The process is not difficult and would have been available to any person to whom the brochure would have been available. Therefore, the Court has ruled that defendant's Exhibit B-24, enlargements of the photographs in Exhibits B-20, B-34, O and P, is properly before the Court.

The Court determines that there has been an anticipatory disclosure of the elements of the claims alleged to have been infringed in this case. The pertinent information in the printed publications available to the public before the critical date in combination with the prior art anticipate the allegedly infringed claims and defeat patentability, *In re Palmquist,* 319 F.2d 547 (C.C.P.A. 1963), *overruled on other grounds, In re Foster,* 343 F.2d 980 (C.C.P.A. 1965).

Each claim consists of one or more elements. Each element will be considered individually. Reference will first be made to the prior art, through other patents or through representations made in the patent in suit. Though the representations made in the patent in suit as to what was known in the field are not themselves disclosures or prior art, they will be considered as evidence of what was known in the field. Reference will be made

to patents including the Stewart patent, defendant's Exhibit A-5, U.S. Patent No. 3,602,146, patented on August 31, 1971; the Plasser British patent, plaintiff's Exhibit 86 and defendant's Exhibit V, which the parties agree is the same as the German patent, defendant's Exhibit W, patented November 18, 1971; the Oville patent, referred to in the file wrapper of the patent in suit, in plaintiff's Exhibit 78; and the Plasser U.S. patent, plaintiff's Exhibit 83, U.S. Patent No. 1,204,133, patented September 3, 1970.

Claim 1

(a) That the gripping members are able to lift the two lines of rail is acknowledged to be old by the patent in suit, column 1, lines 14 through 27, especially lines 18 and 19. The element is found on the Plasser British patent by reference to figure 1 and on the Stewart patent by reference to column 2, lines 50 through 55. The element is also disclosed by the photographs on page 3 of the Matisa B-13 sales brochure, the English language version of which is defendant's Exhibit P.

(b) Gripping members mounted on a support frame are acknowledged to be old by the patent in suit, column 1, lines 14 through 27, especially lines 18 and 19. The element is found on the Plasser British patent, where in figure 3 the lifting tools are mounted on the support beam. The photographs on page 3 of the Matisa B-13 sales brochure also disclose this element.

(c) The support frame is connected to the chassis by articulated connecting members in the patent in suit. That element is acknowledged to be old in the patent in suit, column 1, lines 14 through 27, especially lines 19 and 20. The feature is present in the Plasser British patent, figure

3, and is clearly disclosed in the photographs in the Matisa B-13 sales brochure and in the schematic drawing of the Matisa B-13 in "Courrier Matisa."

(d) A chassis that is movable on the track is acknowledged to be old in the patent in suit itself, column 1, lines 20 through 22. The feature is also present in the other patents before the Court. The fact that the machine is movable is disclosed in the publications, for example, in the note in "Signal und Schiene" in which the machine is referred to as "self-propelled," and in the technical specifications at the end of the Matisa B-13 sales brochure where the drive of the tamping machine is referred to as "travelling and advance when working."

(e) A support frame movable vertically and laterally relative to the chassis by action of the lifting and lining means is not new. This element is acknowledged to be old in the patent in suit, column 1, lines 20 through 25. It is present in the Plasser British patent, figure 3, where the lateral movement is controlled by jacks 30 and 31 and the vertical movement by 32. It is also present in the Oville patent, figure 3, and the Plasser U.S. patent, page 2, lines 20 through 26, 53 through 55, and 86 through 103, as well as claim 5. The hydraulic jacks necessary for effecting the motion described are clearly visible in the photographs in the Matisa B-13 sales brochure. A person skilled in the art could, without the use of his own inventive skill, look at the photograph and determine what effect actuating the jacks would have on the movement of the support frame.

(f) The claim states that there is a gripping member for each side of the track. Gripping members for each side of the track were known. Elements 14 and 15 of the Plasser British patent are gripping members for each side of the track. Element 22 is a gripping member for

each side of the track found in the Oville patent. Claim 6 of the Stewart patent describes a device in which a rail engaging clamp, essentially a gripping member, is provided for each rail. Furthermore, the element is disclosed by the top right hand photograph on the third page of the Matisa B-13 sales brochure in which two gripping members, one for each side of the track, are visible.

(g) Gripping members transversely displaceable substantially in a straight line along the support frame are claimed to be new, in contrast to gripping members that moved in an arc. The movement can be found in the Plasser British patent, claim 3 at lines 110 and 111. The straight line movement of the gripping members is disclosed in the printed publications. In the different photographs in the Matisa B-13 sales brochure, the gripping members are shown mounted on the support frame. The frame is grooved in such a manner as to indicate that some part of the device moves transversely along it; it is clear from the photographs that the movable part is the intermediate support frame on which the gripping members are mounted. In the two photographs at the bottom of page 3, the gripping members are in slightly different relationships in the transverse plane in relation to the support frame. Furthermore, the text on page 3 of the sales brochure states that the clamps are transversely displaceable.

(h) The use of rail engaging means for each side of the track was known. The counter rollers 16 in figure 2 of the Plasser British patent are rail engaging means for each side of the track. In the Stewart patent, flanged wheels are used as rail engaging means, described in claim 6. In the schematic drawing in "Courrier Matisa," a rail engaging means is seen for the one side of the device that

is represented, but there is no question but that the hidden side of the device is identical.

(i) The mounting of the rail engaging means on the support frame was known at the time of the patent application. Claim 8 and figure 4 of the Plasser British patent represent an example of the mounting of the rail engaging means on a support arm. Claim 3 of the Stewart patent is another example. The rail engaging means, as discernible in the schematic drawing in "Courrier Matisa," when compared with the photographs in the Matisa B-13 sales brochure indicate that the same element must not only be present in the photographed device but that the rail engaging means must be encased or supported by the structure that is joined to the support frame on the left and visible in all photographs, but especially the bottom left photograph on the third page. It is clear from the photographs that the rail engaging means is mounted on the support frame.

(j) That the rail engaging means engage the track by facing the gripping members for the same side of the track was known and old. The Stewart patent disclosed such a use in claims 2 and 7. Furthermore, the positioning of the rail engaging means support indicates that the rail engaging means are essentially opposite the gripping members and that they face the gripping members.

The Court determines that the elements of claim 1 of the patent in suit are not patentable because they represent a combination only of what was known in the field and what was disclosed by the printed publications that anticipated the patent.

Claim 2

(a) The sole element of this claim is that the gripping members are vertically displaceable on a straight line relative to the support frame. This feature is apparent from the three pictures found on page 3 of the Matisa B-13 sales brochure, in which the gripping member is found in three different positions relative to the support frame. Furthermore, the claim is disclosed by representations, as in the sales brochure, that the rail can be gripped by the head or by the foot. The construction of the gripping members within the support frame precludes arched displacement consistent with the photographs. Gripping by the railhead or rail base could only be achieved by straight line vertical displacement of the gripping members.

The Court determines that the element of claim 2 of the patent in suit is not patentable because it was disclosed by printed publications that anticipated the patent.

Claim 3

(a) Each gripping member in the patent in suit is height-adjustably mounted on an intermediate chassis. This element is fully disclosed in the photographs in the Matisa B-13 sales brochure. The intermediate chassis or intermediate support frame on which the gripping members are mounted is plain. There is a vertical groove in the center of the intermediate support frame along which the gripping members can move. The gripping members are shown in different positions in the vertical plane in relation to the intermediate support frame, and there can be no other conclusion than that the gripping members are height-adjustable in relation to intermediate support frame.

(b) The intermediate chassis is displaceably mounted on the support frame in a plane parallel to the plane of the track and transversely thereto. This element is disclosed by the presence of grooves in the support frame that correspond to the sides of the intermediate chassis. There can be no other conclusion, when viewed by one skilled in the art, that the grooves in the support frame are guides for the transverse movement, or displaceability, of the intermediate support frame.

The Court determines that elements of claim 3 of the patent in suit are not patentable because they were disclosed by printed publications that anticipated the patent.

Claim 5

(a) The support frame of the patent in suit extends at least over the entire width of the track. This element is disclosed by the schematic drawings appearing in "Courrier Matisa" and in the note in "Signal und Schiene," as well as in the photographs in the Matisa B-13 sales brochure.

(b) That the support frame supports the gripping members and rail engaging means of two lines of rails is not new. The same element is present in claim 3 of the Stewart patent. Further, the element is disclosed by the photographs in the Matisa B-13 sales brochure, where it is entirely clear that nothing else could be supporting either the gripping members or the rail engaging means, or to state it in the positive, that the support frame supports the gripping members and the rail engaging means.

The Court determines that the elements of claim 5 of the patent in suit are not patentable because they were disclosed by printed publications that anticipated the patent.

Claim 6

(a) The sole element of claim 6 is that the articulated connecting members from the support frame to the vehicle chassis are the control members for moving the support frame longitudinally or rotating in a plane parallel to the plane of the track. This feature is disclosed by the language of the Matisa B-13 sales brochure, especially in conjunction with the photographs. The sales brochure states that the frame is "adjustable in the longitudinal direction . . . (and) is also inclinable." The rotating movement is also disclosed in the technical specifications on page 4 of the sales brochure, where a slewing range is given, indicating an ability for the device to turn on its own axis. A person skilled in the field could determine, without resort to his own inventive skills, that these movements are accomplished by use of the articulated connecting members, hydraulic jacks, clearly visible in the photographs in the Matisa B-13 sales brochure.

The Court determines that the element of claim 6 of the patent in suit is not patentable because it was disclosed by printed publications that anticipated the patent.

Claim 11

(a)-(g) These elements are the same as the elements of claim (1) and the discussion of those elements is incorporated by reference here.

(h) This element is the same as the element in claim 2 and the discussion of that element is incorporated by reference here.

(i) The use of rail engaging means comprising single flange wheels for each side of the track was known before the critical date and therefore was not novel. The

Plasser British patent describes flanged counter rollers, essentially flanged wheels operating on each side of the track to face the gripping members, at page 2, lines 58 through 67. Flanges on wheels used on the interior edge of a rail to cooperate with the exterior gripping or rail engaging mechanism has been long known. An interior flanged wheel is found in the Mannix British patent, plaintiff's Exhibit 85, patented April 14, 1966. Flanged rollers may also be found in the Stewart patent, column 3, line 45 and following lines. The existence of the rail engaging means was disclosed as discussed under claim 1, and the further element of flanged wheels was known.

(j) That the single flange wheels are mounted on the support frame is not new. Reference to element 16 in figure 2 of the Plasser British patent and reference to the mounting of flanged rollers 743 and 745 on the support frame 35 in figure 7 of the Stewart patent indicate that this element of claim 11 was known, and is therefore not novel with the patent in suit.

(k) In the patent in suit the single flange wheels rest in operative position vertically and horizontally on the rails. This element is the same element found in column 3, lines 39 through 59 and in claim 7 of the Stewart patent. The element was known, and therefore was not novel with the patent in suit.

(l) The single flange of the wheels in the patent in suit face the gripping members for the same side of the track. This element is not new. The Plasser British patent states that each counter-roller is arranged opposite the associated lifting roller, page 2, lines 58 through 60. The facing element is also known in the Stewart patent, claim 6. The existence of facing rail engaging means was discussed in claim 1, and the further element of flanged wheels was not novel.

The Court determines that the elements of claim 11 of the patent in suit are not patentable because they represent elements that were known in the field, elements that were disclosed in printed publications that anticipated the patent or a combination of both.

The Court finds the claims 1, 2, 3, 5, 6 and 11 of the patent in suit, U.S. Patent Re. No. 29,437 to be unpatentable. Since the claims are not properly patentable, there can be no issue of infringement.

The Court does not find that this case presents an exceptional case under 35 U.S.C. § 285, and therefore does not award attorneys' fees to the defendant in this case. The publication upon which the Court has most heavily relied was disseminated approximately two weeks prior to the critical date. One of the patents considered crucial as prior art was patented less than two weeks before the critical date. The representations made by the plaintiff to the Patent Office cannot be said to have been intentionally misleading.

The Court also does not find that the plaintiff should bear attorneys' fees as sanctions under Fed. R. Civ. P. 35. The Court determines that many years have passed since the documents whose production is in dispute were printed or published, and that the documents sought were in several countries. Though the plaintiff failed to provide answers and admissions related to documents and failed to produce documents sought by the defendant, the Court cannot find that the plaintiff was guilty of bad faith in its failure to provide such answers, admissions and documents as promptly as the Court would have liked.

Judgment will be entered for the defendant.

June 15, 1978
Norfolk, Virginia

J. Calvitt Clarke, Jr.
United States District Judge

UNITED STATES DISTRICT COURT

For The
Eastern District of Virginia
Norfolk, Virginia

Civil Action File No. 77-294-N

CANRON, INC.

vs.

PLASSER AMERICAN CORPORATION

JUDGMENT

This action came on for trial before the Court, Honorable J. CALVITT CLARKE, JR., United States District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered,

It is Ordered and Adjudged that the plaintiff take nothing, that the action be dismissed on the merits, and that the defendant Plasser American Corporation recover of the plaintiff Canron, Inc. their costs of action and further denying defendant's motion to impose sanctions against the plaintiff.

Dated at NORFOLK, VIRGINIA, this 16th day of June, 1978.

W. FARLEY POWERS, JR.
Clerk of Court

JEAN F. SUMMERS
Deputy Clerk

APPENDIX D

Statutory Provisions Involved
35 U.S.C. §§ 102, 103

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Supreme Court, U. S.
FILED
MAY 2 1980
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1556

CANRON, INC.,

Petitioner,

vs.

PLASSER AMERICAN CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

ALFRED H. PLYER, JR.,
Attorney for Respondent.

Gunthorp-Warren Printing Company, Chicago • Financial 6-6565

IN THE

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OCTOBER TERM, 1979

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CANRON, INC.,

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Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is a routine patent case of interest only to the litigants. Petitioner comes to this Court with adverse findings of fact, conclusions of law and a judgment of the trial court which has the full concurrence of the Court of Appeals per curiam. That Court affirmed "on the trial court's comprehensive Findings of Fact and Conclusions of Law" (A-3). None of the reasons outlined in Rule 19 govern the petition.

The petition presents no principle of importance to the public as distinguished from that of the parties and asserts no real and embarrassing conflict of opinion and authority between different Courts of Appeals. The Petition for the Writ of Certiorari should be denied on the authority of *Layne & Bowler Corp.* v. *Western Well Works,* 261 U. S. 387 at page 393 (1923).

Petitioner's complaint is that its minor patent was held invalid under 35 USC 102(b) because it was "anticipated" by more than one reference whereas the Fourth Circuit in *Tights, Inc.* v. *Acme-McCrary Corp.*, 541 F. 2d 1047 (4th Cir. 1976), *Cert. Denied*, 429 U. S. 980 (1976) said that anticipation requires a full disclosure in one reference. Petitioner contends that the holding here conflicts with *Tights* and with the decisions of virtually all of the Circuit Courts of Appeal which have required that an anticipation under 35 USC 102(b) calls for a full disclosure in a single reference. Petitioner dramatizes this in a chart on page 4 of its Petition where it purports to portray some nine references allegedly used by the District Court against the elements of the principal claims of its patent.

Petitioner fails to point out that four of the references are Petitioner's own prior art publications disclosing its own machine. Three of the publications are *identical* to what is shown in the patent (Exhibits B-20, A-20 and U). These are all publications concerning the same machine disclosing different aspects of it with a good deal of overlap. These constitute one publication although serialized. A series of publications on the same machine by the same source qualify as a "single publication", see *Deep Welding, Inc.* v. *Sciaky Bros., Inc.*, 417 F. 2d 1227, 1239 (7th Cir. 1969).

Petitioner's own prior art publications, either singly or as a group, constitute a complete anticipation. The prior art description must be sufficient to enable one to make the invention, see *Seymour* v. *Osborne*, 78 U. S. (11 Wall) 516, 20 L. Ed. 33 (1871) and *Cohn* v. *United States Corset*, 93 U. S. 366, 23 L. Ed. 907 (1876). Such was the case here.

Petitioner forfeited his right to a patent by distributing his own printed publications of the precise subject matter of the patent more than one year before his U. S. filing date in violation of 35 USC 102(b). The requirement of 35 USC 102(b) is the very foundation of the patent system—the government's grant of a limited monopoly in return for an early disclosure to

the public of the patented subject matter. *Pennock* v. *Dialogue*, 27 U. S. (2 Pet.) 1, 7 L. Ed. 327 (1829). This statutory provision is bottomed on three policies; first, to avoid detrimental public reliance upon a product appearing in the public for a significant period of time without an assertion of patent rights; second, to encourage prompt disclosure of new and useful information; and, third, to discourage attempts to extend the length of the patent by commercially exploiting a new invention and only applying for a patent when faced with competition.

Petitioner has violated the basic purpose of the patent system —filing his patent application over one year after publicizing the subject matter thereof. He has forfeited his rights.

Petitioner's patent was also anticipated under 35 USC 102(b) by one of respondents prior patents (Exhibit 86). The other four references in petitioner's chart on page 4 of its petition merely illustrated minor unimportant details and were used under 35 USC 102(b) in the sense of *Struthers Scientific & International Corporation* v. *Rappl & Hoenig Co., Inc.*, 453 F. 2d 250, 254 (2nd Cir. 1972).

In summary, respondent urges that the District Court properly dismissed Petitioner's complaint and granted appropriate relief under the circumstances. The Court of Appeals properly ruled with respect to all matters of which complaint has been made in the petition. There is no conflict here with decisional law of this or any other circuit. The issues present no matters of general public interest. The Petition should, we submit, be denied.

Dated, Chicago, Illinois this ..... day of ....., 1980.

Respectfully submitted,

ALFRED H. PLYER, JR.,
Attorney for Respondent.

Supreme Court, U.
FILED
MAY 15 1980
MICHAEL RODAK, JR., CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1979

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Respondent.

PETITIONER'S REPLY BRIEF IN RESPONSE TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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PETITIONER'S REPLY BRIEF IN RESPONSE TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Respondent's Brief in Opposition predictably states that this dispute involves only a minor patent and that it is a "routine" case, "of interest only to the litigants." This is erroneous. This case presents a substantive issue of great significance to the American patent system, as to which a clear and direct conflict exists between the various Courts of Appeals. The Court of Appeals for the

Fourth Circuit held that anticipation under 35 U.S.C. 102(b) can be based on the additive disclosure of two or more references, contrary to its often quoted case *Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047 (4th Cir. 1976).

Respondent's Brief also seeks to direct this Court's attention away from the aforesaid conflict by contending that the Petitioner's patent here *was* in fact anticipated in one or more single references. This contention, however, stands in direct opposition to the facts found by the Trial Court, as demonstrated in the chart on page 4 of the Petition. Significantly, Respondent does not challenge the correctness of that chart and it instead sets forth in its Brief its own interpretation of the evidence below. The present proceeding, however, is hardly an appropriate forum for that type of presentation and the Petitioner submits that this Court should instead direct its attention to the actual findings below, as summarized in the aforesaid chart.

If, however, the Court nevertheless finds it necessary to go behind the findings below, it must then recognize that the Respondent's discussion of the evidence is misleading in a number of critical areas.

Thus, Respondent's statement, in the second full paragraph on page 2 of its Brief, that Exhibits U, A-20, and B-20 are publications which provide identical disclosures to the patent in suit is plainly false. The Trial Court found only two claim elements in Exhibit U. The Trial Court found only four claim elements in Exhibit A-20. The Trial Court found less than all of the claim elements in Exhibit B-20. Furthermore, summation of the claim elements disclosed in Exhibits B-20, A-20, and U still does *not* provide disclosure of all of the claim elements.

The characterization of a short article in German (Exhibit U), a sketch or drawing with a short description in French (Exhibit A-20), and a brochure in French (Exhibit B-20) as a series so as to constitute one document is clearly without support. Even if "serialized," no anticipation would result as there is still no disclosure of claim element (j) of Claim 1 and claim elements (i) through (l) of Claim 11.

Respondent's statement, in the third full paragraph of page 2 of Respondent's Brief, that anticipation is provided by the prior art publications, either singly or as a group, is totally in error. None of the references were found by the Trial Court to disclose all of the claim elements.

Referring to the paragraph bridging paragraphs 2 and 3 of Respondent's Brief, the publication which was found to have been distributed more than one year prior to the U.S. filing date, i.e., the B-13 brochure (Exhibit B-20) was not found by the Trial Court either to anticipate the claims in suit or to disclose all of the elements thereof. The chart contained in the Petition clearly shows the failure of the B-13 brochure to disclose elements (h) and (j) of Claim 1 and elements (i) through (l) of Claim 11.

Referring to the second full paragraph on page 3 of Respondent's Brief, the allegation therein that Respondent's patent Exhibit 86 also anticipated Petitioner's patent is clearly false. Resort to the chart provided in the Petition clearly discloses that the Trial Court did not find disclosure of all of the claim elements in Exhibit 86. In particular, the Trial Court did not find that Exhibit 86 disclosed element (j) of Claim 1 or elements (h) and (k) of Claim 11.

While the Trial Court held that all of the elements of the claims were anticipated because they were found separately in various prior art references, the Trial Court did not hold that any one reference or any specifically defined group of references were anticipatory. There was no finding or conclusion of obviousness.

Petitioner again respectfully submits that its Petition brings to this Court subject matter which is of substantial importance, not only to the litigants, but to the jurisprudence of the country as a whole, and again requests that its petition be granted.

Respectfully submitted,

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